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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,489	12/10/2004	Mitsuteru Kataoka	2004-1957A	5567
513 7590 08/09/2007 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER HO, ANDY	
			ART UNIT 2194	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/517,489

**Applicant(s)**

KATAOKA, MITSUTERU

**Examiner**

Andy Ho

**Art Unit**

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/10/04; 5/23/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is in response to the application filed 12/10/2004.
2. Claims 1-20 have been examined and are pending in the application.

### ***Claim Objections***

3. Claims 10 and 19-20 are objected to because of the following informalities: the parentheses, which contain numbers from figures, need to be removed. Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-9 and 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to define the metes and bounds of an invention comprised of software alone without claiming associated computer hardware required for execution. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Simpson U.S Patent No. 6,944,868.

**As to claim 1**, Simpson teaches a safe service extension platform in which services are associated with an execute form (implementing extension in a browser, lines 13-29 column 8), and the services are extended by changing or adding the execute form (lines 30-64 column 8), the platform comprising a service-dependent API for extending the services (...the imaging extension may be implemented of as an application programming interface...), wherein the service extension from the execute form is carried out only by calling the service-dependent API (...the generic access instructions from the web content, when executed, may cause imaging extension API calls to be issued to the API in order to effect..., lines 16-19 column 8) .

**As to claim 2**, Simpson further teaches the service extension is to provide a new service (lines 6-22 column 11, lines 39-46 column 12).

**As to claim 3**, Simpson further teaches the service extension is to start using a service (lines 30-64 column 8).

**As to claim 4**, Simpson further teaches the extension of a target service is carried out only by calling the service-dependent API from an execute form associated with the target service (lines 41-64 column 8).

**As to claim 5**, Simpson further teaches a parent/child relationship is defined between a plurality of services, and in the case where a call for the service-dependent API requested by the execute form designates, as a process target, a service-dependent resource associated with a service, only when a service associated with the execute form is an ancestor of that service, service-dependent resource can be processed (lines 16-48 column 13).

**As to claim 6**, Simpson further teaches an execute form associated with a metaservice at least one of the services can be extended by the service-dependent API (lines 13-46 column 12).

**As to claim 7**, Simpson further teaches in the case of the execute form associated with the metaservice, all of the services can be extended by the service-dependent API, and in the case where the execute form is not associated with the metaservice, the service-dependent API is unable to extend the services (lines 13-46 column 12).

**As to claim 8**, Simpson further teaches the execute form is a control content which satisfies requirements that are to be satisfied by contents, the control content is transmitted as a content together with at least one of the contents, information for designating the control content from at least one of the

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contents, and the service-dependent API can be processed only by the control content (lines 13-46 column 12).

**As to claim 9**, Simpson further teaches the service-dependent API controls automatic storage of a specific service content (lines 13-46 column 12).

**As to claim 10**, Simpson further teaches the execute form is sent from at least one service provision portion, and received by at least one terminal device for executing the execute form (line 50 column 10 to line 5 column 11).

**As to claim 11**, it is a method claim of claim 1. Therefore, it is rejected for the same reasons as claim 1 above.

**As to claim 12**, it is a computer program product claim of claim 1. Therefore, it is rejected for the same reasons as claim 1 above.

**As to claims 13-14**, they are system claims of claim 4. Therefore, they are rejected for the same reasons as claim 4 above.

**As to claims 15-16**, they are system claims of claim 5. Therefore, they are rejected for the same reasons as claim 5 above.

**As to claims 17-18**, they are system claims of claim 6. Therefore, they are rejected for the same reasons as claim 6 above.

**As to claims 19-20**, they are system claims of claim 10. Therefore, they are rejected for the same reasons as claim 10 above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy Ho whose telephone number is (571) 272-3762. A voice mail service is also available for this number. The examiner can normally be reached on Monday – Friday, 8:30 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIM) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Any response to this action should be mailed to:

Commissioner for Patents

P.O Box 1450

Alexandria, VA 22313-1450

Or fax to:

- AFTER-FINAL faxes must be signed and sent to (571) 273 - 8300.

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- OFFICAL faxes must be signed and sent to (571) 273 - 8300.
- NON OFFICAL faxes should not be signed, please send to (571) 273 –

3762

A.H

August 6, 2007

A handwritten signature in black ink, appearing to be 'A.H.' with a stylized flourish extending to the right.